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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/529,495

03/29/2005

Akira Kuramori

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12/13/2006

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EXAMINER

STORMER, RUSSELL D

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------|-----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/529,495 | KURAMORI ET AL. | |
| | Examiner | Art Unit | |
| | Russell D. Stormer | 3617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-8 and 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/05</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Restriction Requirement

1. Applicants' election with traverse of the invention of Species III, claims 1, 3, and 4 in the reply filed on September 28, 2006 is acknowledged.

Claims 2, 3, 5-8, and 10-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. Applicants timely traversed the restriction (election) requirement in the reply filed on September 28, 2006.

2. Applicants' election with traverse of the species election requirement in the reply filed on September 28, 2006 is acknowledged. The traversal is on the ground that the requirement did not explain why each group lacks unity with each other group. This is not found persuasive because in paragraph 2 of page 3 of the requirement, the explanation of the lack of unity is clearly set forth. The pertinent portion of this paragraph is reproduced below for Applicants' convenience:

Species I and II differ from each other in that the resin layer is on the support or the tire. Species IV differs from the other three in that the resin layer is rotatable on the support. Species III differs from the other three in that the resin layer is structurally different from the resin layers of the other species.

Therefore, Applicants' reason for traversal is erroneous and the requirement is still deemed proper and is therefore made FINAL.

3. Applicants' election of "alleged Species III, having claims 1 and 3-4" is noted. However, Species III is drawn to the resin layer, and not structure of the run-flat insert. Therefore, claim 3 is withdrawn from consideration as it is drawn to species I, II, and IV.

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However, claim 9 appears to be drawn to elected Species III and will be examined on the merits.

Specification

4. The disclosure is objected to because of the following informalities: The specification does not include a heading for the DETAILED DESCRIPTION OF THE INVNEITON as required. The heading could be inserted before either of paragraphs 0011 or 0023.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

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- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerloff et al in view of Peterson et al.

Gerloff et al discloses a tire and wheel assembly comprising a wheel, a tire, and a run-flat support in the cavity of the tire. The run-flat support shown in figures 9 and 10

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includes a friction strip 12 and a lubricant 13 or a guide element 19. As noted in lines 53-61 of column 4, the friction strip as shown in figure 10 may be made of a self-lubricating material such as PTFE, or any other suitable material, and the lubricant or slide means may then be eliminated. Gerloff et al notes that materials other than PTFE can be used for the strip 12, but does not specifically mention a microcapsule-impregnated resin.

Peterson et al teaches a slide element for the slide rail of an endless track vehicle. The slide element such member 21 may be formed from a self-lubrication material, and the material may be lubricant-containing microcapsules dispersed throughout the material. See lines 6-45, and especially lines 21-30, of column 5.

From this teaching it would have been obvious to substitute a self-lubricating material having microcapsules formed therein for the PTFE material friction strip of Gerloff et al as this would have been an effective way to distribute lubricant on the outer surface of the run-flat support of Gerloff et al without having to actually apply a separate lubricant to the support.

Both Gerloff et al and Peterson et al teach the use of self-lubricating materials on the bearing surface of a metal member that is to be in contact with a rotating rubber article and to prevent heat build-up during such contact. Further, Gerloff et al and Peterson et al use the self-lubricating materials in lieu of liquid lubricants because the environments they are used in. It is submitted that Gerloff et al and Peterson et al solve similar problems in similar fields of endeavor.

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Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other run-flat supports and/or lubricating materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/8/06


RUSSELL D. STORMER
PRIMARY EXAMINER *12/8/06*